

II. REMARKS

The First Office Action on the merits in this application, dated January 11, 2007 (hereinafter “First Office Action”), and any references cited therein have been carefully reviewed; this amendment is intended to be fully responsive to the First Office Action. Claims 1-22 are in the application. Pursuant to the Response to Restriction Requirement, filed on November 1, 2006, Applicants have withdrawn claims 17-22 from consideration. Moreover, all pending claims, i.e., claims 1-16, presently stand rejected. After entering this amendment, claims 1-16 remain pending. Reconsideration and reexamination of this application in view of the following remarks is herein respectfully requested.

A. CLAIM REJECTIONS - 35 U.S.C. § 103

All pending claims, claims 1-16, stand rejected under 35 U.S.C. § 103(a) (hereinafter “103”) as being unpatentable, at least in part, over U.S. Patent No. 6,089,999 to Imaida et al. (hereinafter “Imaida”) in view of U.S. Patent No. 6,367,151 to Schlegel et al. (hereinafter “Schlegel”). Claims 1, 8-10 and 14-16 stand rejected under 103 as being unpatentable solely over Imaida in view of Schlegel. Claims 3 and 11-12 are rejected under 103 as being unpatentable over Imaida and Schlegel, and further in view of European Patent No. EP 10209246 to Knepper et al. In addition, Claims 2, 4, and 5 are presently rejected under 103 as being unpatentable over Imaida and Schlegel as applied to claim 1, and further in view of U.S. Patent No. 6,435,830 to Allen et al. Claim 6 stands rejected under 103 as being unpatentable over Imaida and Schlegel as applied to claim 1, and further in view of Netherlands Patent No. KR 2005065911A to Kim et al. Finally, claims 7 and 13 are rejected under 103 as being unpatentable over Imaida and Schlegel as applied to claim 1 above, and further in view of U.S. Patent No. 5,714,205 to Marantz et al.

A proper rejection under 35 U.S.C. § 103(a) requires that the Examiner establish *prima facie* obviousness. As stated in the MPEP, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP 2142 (emphasis in original). Three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

In making an obviousness analysis, “the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP 2141.02, citing Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983).

Applicants submit that the Examiner has not established *prima facie* obviousness with respect to claims 1-16 for at least two reasons: first, the rejected claims recite elements and limitations that are not taught or suggested by the cited references and, therefore, the third criterion necessary to establish *prima facie* obviousness has not been satisfied. Secondly, the Examiner has not provided a proper motivation or suggestion to combine the references cited and, thus, the first criterion necessary to establish *prima facie* obviousness has not been satisfied.

I. The prior art references do not teach or suggest each and every element and limitation set forth in the rejected claims.

In rejecting claims 1, 8-10 and 14-16, the Examiner properly observes that “Imaida et al. discloses a transmission comprising a housing (103) having a bore, a bearing (101) within the bore, the bore includes a sleeve (as well known in the art)”, and notes that “Imaida et al. fails to disclose the thermal spray coating between the bearing and the housing.” First Office Action, at 2-3, item No. 5. In a similar regard, the Examiner goes on to note that “Imaida et al. is silent concerning the material for the housing.” *Id.* at 3. In recognizing these apparent omissions from Imaida, the Examiner thereafter maintains that, because “Schlegel et al. discloses a bore of a connecting rod (1) is plasma coated (thermal spray coating) to increase the frictional surface of the bore and to reduce expansion due to extreme heat conditions ... it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bore of the housing of Imaida et al. so that the bore is thermally coated in view of Schlegel et al. in order to increase the frictional surface of the bore and to reduce expansion due to extreme heat conditions.” *Id.* The Examiner similarly finds that since “[i]t is well known in the art that housings made from aluminum are lighter without compromising strength ... it would have been obvious to nr [sic] of

ordinary skill in the art at the time of the invention to produce the housing out of aluminum in order to reduce the weight of the transmission.’ Id.

As noted by the Examiner, both Imaida and Schlegel fail to recite “an aluminum housing member”, similarly required by both base claims 1 and 11. The mere fact that Imaida’s transmission casing 103 may be produced out of aluminum, as maintained by the Examiner, is not sufficient under MPEP and Statutory standards to establish the inherency of that result or characteristic. See MPEP 2112(IV); In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (court reversed decision of the board to uphold rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art.); In re Oelrich, 666 F.2d 578, 581-82 (CCPA 1981) (“Inherency ... may not be established by probabilities or possibilities.”). Moreover, the Examiner points to the bore 3 in Schlegel’s connecting rod 1, which is also not aluminum. This is the “large eye in a cracked connecting rod of an engine”, rather than an “aluminum housing member” of a “transmission”. Thus, the large eye in Schlegel is not a “bore formed” in “an aluminum housing”, but a notch burned by a laser or produced by a broach in a non-aluminum connecting rod. Schlegel, Col9, lines 46-60. Accordingly, a *prima facie* case of obviousness is not properly established, since each and every limitation recited in the rejected claims is not taught or suggested by the prior art cited by the Examiner. See MPEP § 2143.03. See also, In re Royka, 490 F.2d 981 (CCPA 1974).

II. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of invention, to modify the Imaida reference based upon the teachings of Schlegel.

An Examiner may combine the teachings of multiple prior art references to produce the claimed invention and establish § 103 (a) obviousness only where there is a teaching, suggestion, or motivation to do so, found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See § 2143.01(I). Even if the proposed combination of references were to teach each and every element of the claimed invention, a rejection based on a *prima facie* obviousness is improper without a motivation to make the combination. See Id. See also, In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination.” MPEP § 2143.01(III), (emphasis in original). See also, In re Mills, 916 F.2d 6801 (Fed. Cir. 1990).

The Examiner has not provided an explicit motivation or suggestion in the prior art to make the proposed combination of Imaida and Schlegel. Rather, the Examiner finds that one of ordinary skill in the art would be motivated to modify Imaida’s pulley arrangement for a belt-type CVT according to Schlegel’s modified internal combustion engine connecting rod “in order to increase the frictional surface of the bore and to reduce expansion due to extreme conditions.” First Office Action, at 3, item No. 5. Applicants have reviewed both the Imaida and Schlegel references and were unable to find this proposed motivation therein. If the Examiner believes that the motivation to make the suggested combination is expressly present in the prior art, Applicants invite the Examiner to provide such express notation. Alternatively, if the Examiner is to maintain that the proffered motivation is inherently part of the knowledge in the art, Applicants request the Examiner to provide evidence on the record to support this statement as required by the MPEP. MPEP 2144.03 (C) (If an applicant adequately challenges a factual assertion as not properly based upon common knowledge, “the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.”)

In light of the remarks set forth above, Applicants submit that the 103 rejection of independent claims 1 and 11 under Imaida in view of Schlegel is improper and, therefore, should be withdrawn. Consequently, any corresponding or subsequent 103 rejections of claims 2-10, which depend ultimately from base claim 1, and claims 12-16, which depend ultimately from base claim 11, are also believed to be improper for at least those reasons as the base claims from which they depend. Applicants submit that any further combination of prior art with Imaida and Schlegel proposed by the Examiner does not cure the omission and deficiencies identified above.

III. CONCLUSION

In consideration of the remarks set forth above, this paper is believed to be fully responsive to the First Office Action dated January 11, 2007. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested. In the event formal matters remain, the Examiner is invited to call the undersigned to discuss those matters before further action is taken.

Please charge any fees associated with this amendment to deposit account 07-0960.

Respectfully submitted,

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